

Attorney Docket No.: **DEX0491US.NP**  
Inventors: **Papkoff et al.**  
Serial No.: **10/562,259**  
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**REMARKS**

Claims 1-3, 6, 8, 10, 16, 19, 20, 22, 23, 30, 31, 35, 37, 39, 47, 61-63 and 72-81 are pending in the instant application. Claims 30, 31, 35, 37, 39, 47 and 61-63 have been withdrawn from consideration by the Examiner. Claims 74-81 are allowed, Claims 6, 19 and 23 are objected to. Claims 1-3, 8, 10, 16, 20, 22, 72 and 73 have been rejected. Claims 2, 3, 6, 8, 19, 20, 22, 30, 61 and 72 have been amended. Claims 1 and 16 have been canceled. New claims 82-115 have been added. Support for these amendments is provided in the original claims and teachings in the specification at, for example, page 29, lines 9-13 and page 59, lines 6-17. No new matter is added by this amendment. Reconsideration is respectfully requested in light of these amendments and the following remarks.

**I. Rejection of Claims 1, 3, 16 and 20 under 35 U.S.C.**

**102(b)**

The rejection of Claims 1, 3, 16 and 20 under 35 U.S.C. 102(b) as being anticipated by Antalis et al. (U.S. Patent 6,479,274) and/or Bandman et al. has been maintained. The Examiner suggests that while Antalis et al. and Bandman et al. do not specifically state the antibodies would bind in vivo, this limitation of the claim is a characteristic of a Pro104 antibody and is an inherent characteristic.

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While Applicants respectfully disagree that this is an inherent characteristic of all antibodies, in an earnest effort to advance the prosecution of this case, Applicants have canceled claims 1 and 16 and amended claims 3 and 20 to depend from claims 6 and 19, respectively.

Withdrawal of this rejection is therefore respectfully requested.

**II. Rejection of Claims 1-3, 8, 10, 16, 20, 22, 72 and 73 under 35 U.S.C. 103(a)**

Claims 1-3, 8, 10, 16, 20, 22, 72 and 73 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Bandman et al. (U.S. Patent 6,203,979) in view of Queen et al. (U.S. Patent 6,180,370). The Examiner suggests that Bandman et al. discloses antibodies which specifically bind HUPM (which has the same sequence as Pro104) may be used for the diagnosis of disorders characterized by expression of HUPM. The Examiner has acknowledged that Bandman et al. does not specifically state the antibodies would bind in vivo. However, the Examiner suggests that this limitation of the claim is a characteristic of a Pro104 antibody and is an inherent characteristic. Further, the Examiner suggests that Queen et al. provides support for the limitations of a humanized antibody conjugated to toxins or a detectable label.

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As discussed in Section I, however, while Applicants respectfully disagree that this is an inherent characteristic of all antibodies, in an earnest effort to advance the prosecution of this case, Applicants have canceled claims 1 and 16 and amended claims 2-3, 8, 10, 16, 20, 22, 72 and 73 to ultimately depend from either claims 6 and 19.

Withdrawal of this rejection is therefore respectfully requested.

### **III. Objection to Claims 6, 19 and 23**

Claims 6, 19 and 23 have been objected to as being dependent upon a rejected claim. The Examiner has acknowledged these claims to be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Accordingly, in an earnest effort to advance the prosecution of this case, Applicants have amended claims 6 and 19 to be independent and to include all of the limitations of the base claim and any intervening claims. Claim 23 has been amended to ultimately depend from claim 6.

Withdrawal of this objection and allowance of these claims as well as claims dependent therefrom is respectfully requested.

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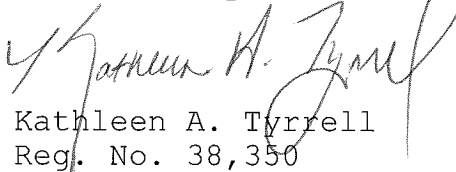
#### **IV. Rejoinder**

Claims 30, 31, 35, 37, 39, 47 and 61-63 have been amended to be dependent upon allowable product claims. New claims 82-115 supported by the original claims and teachings in the specification at, for example, page 29, lines 9-13 and page 59, lines 6-17, are also dependent upon allowable product claims. Accordingly, rejoinder and allowance of these claims is respectfully requested.

#### **V. Conclusion**

Applicants believe that the foregoing comprises a full and complete response to the Office Action of record. Accordingly, favorable reconsideration and subsequent allowance of the pending claims is earnestly solicited.

Respectfully submitted,

  
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